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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): D0932-00411

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

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Application Number	Filed
10/807,058	03/23/2004

First Named Inventor: YANG

Art Unit	Examiner
1771	Torres Velazquez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 42,763
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Won Joon Kouh/
Signature

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Telephone number

January 15, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **YANG et al.** : Confirmation No.: **4035**

Application No.: **10/807,058** : Group No.: **1771**

Filed: **03/23/2004** : Examiner: **Torres Velazquez, Norca Liz**

For: **INSULATION PRODUCT FROM ROTARY AND TEXTILE INORGANIC FIBERS AND THERMOPLASTIC FIBERS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

I. Introductory Comments

This Pre-Appeal Brief Request for Review is being filed along with a Notice of Appeal and in response to the Final Official Action dated August 2, 2006, and the Advisory Action dated November 14, 2006. In the Advisory Action, the examiner entered the After Final amendment filed September 29, 2006 for the purposes of appeal but did not allow the amended claims. Thus, the claims on appeal are in the listing of claims filed on September 29, 2006 in the After Final amendment.

For the reasons summarized below, the rejections of record in the Advisory Action are clearly not proper because of their legal deficiencies.

II. ARGUMENTS

A. Obviousness Rejection of Independent Claims 1, 27 and 48

In the Advisory Action, the examiner rejects the independent claims 1, 27 and 48, as amended after final, as being obvious in view of Brandon (US 4,849,281) because the range of textile glass fibers taught by Brandon would be optimized by one of ordinary skill in the art by the desire to optimize the flexibility of the insulation product which is a result-effective variable. (See Advisory Action, Continuation of 11 in the Continuation Sheet, lines 6-10). Although the

examiner did not explicitly cite the statute, Applicant assumes that 35 U.S.C. § 103 is the basis for the examiner's rejection.

> Claims 1, 27 and 48, as amended after final rejection, all recite a limitation:
>
> . . . the total glass fiber content is about 30-5- wt. % of said insulation product and **said textile glass fibers make up less than about 20 wt. % of the total glass fiber content of said insulation product**.

(emphasis added). As explained by the Applicant in the After Final amendment, this limitation requires that the textile glass fiber content of the insulation product is less than 6 to 10 wt. % of the total insulation product. The textile glass fiber content is controlled to this low level because too much textile fibers results in inferior insulation property. (Specification at paragraph [0004]). Also, according to the specification of the present application, the textile glass fibers are added to the claimed insulation product in the first place in order **to improve tensile strength**. (Specification at paragraph [007]).

The cited reference, Brandon, teaches an insulation product of wool and textile fiber blend whose textile glass fiber content is **10-30 wt. %** as the "optimum ratio" for blending wool and textile glass fibers to produce the preferred embodiment. (Brandon at col. 3, lines 1-13). Thus, the textile glass fiber content in Brandon is not within the range claimed in claim 1.

Further, as noted by the examiner in the Advisory Action, Brandon teaches optimizing the ratio of wool fibers to the textile glass fibers to control **the flexibility** (also referred to as the compressibility in Brandon) of the final product. (Brandon at col. 2, lines 62-68; col. 4, lines 3-5; Advisory Action).

However, the examiner concludes that "the range of 10-30 percent by weight of the textile fibers is a preferred embodiment and does not preclude optimization of the ratio of these materials relative to the intended use of it. . . . It is well settled that determination of optimum values of cause effective variables, such as **flexibility**, is within the skill of one practicing the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980)." (emphasis added) (See Advisory Action). This allegedly obviates the amended claim 1 in view of the teachings of the Brandon reference under 35 U.S.C. § 103.

B. Improper Result-Effective Variable

The examiner's rejection of amended claim 1 under 35 U.S.C. § 103 based on the above reasoning is improper because the variable "flexibility" discussed in the Brandon reference and identified by the examiner is not a relevant "result-effective variable" here. MPEP § 2144.05, II, B. states:

> A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to cont[]actor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to cont[]actor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.) See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1908) . . . .

Unlike the teachings of Brandon, in the claimed invention, the particular claimed wt. % content of the textile glass fibers is driven by the need to achieve enhanced **tensile strength** in the final product. (Specification at paragraph [0007]). As in *In re Antonie*, the Brandon reference does not recognize that tensile strength is a function of the textile glass fiber content, and therefore the parameter optimized was not recognized in the Brandon reference to be a result-effective variable. Thus, the teachings of Brandon with regard to any optimization of the **flexibility** of the final product does not provide the proper motivation to modify the disclosed amount of textile glass fibers from 10-30 wt. % to that of the claimed lower range which is an aspect of the claimed invention that was defined to achieve a desired **tensile strength**. Therefore, the rejections of record do not establish a *prima facie* case of obviousness for the independent claims 1, 27 and 48 under 35 U.S.C. § 103. The rejections of claims 1, 27 and 48 should be withdrawn.

Claims 2-12, 15-26, 28-38, 41, 42, 49-53 all include the above discussed limitation of claims 1, 27 and 48 through their dependence thereof. Therefore, the rejections of record also do not establish a *prima facie* case of obviousness for claims 2-12, 15-26, 28-38, 41, 42, 49-53. The rejections of claims 2-12, 15-26, 28-38, 41, 42, 49-53 should be withdrawn.

III. Conclusion

Applicants submit that this case is appropriate for Pre-Appeal Brief Conference as there are clear legal deficiencies in the obviousness case set forth in the Action. Pre-Appeal Brief Conference is, therefore, requested and an appropriate decision is earnestly solicited.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679.**

Respectfully submitted,

Dated: January 15, 2007

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